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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,353	09/23/2003	Michael J. Cleary	47004.00252	3390
21967 7590 08/16/2007 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER SHRESTHA, BIJENDRA K	
			ART UNIT 3691	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/667,353

Applicant(s)

CLEARY ET AL.

Examiner

Bijendra K. Shrestha

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: ____                           |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/11/2006, 05/08/2006, and 09/23/2003.

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement (IDS) filed 07/14/2006, which contains 28 pages of references, has not been considered. Applicant is required to limit and mark the relevant references so that the Examiner can review them.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-22 and 24-26 are rejected under 35 U.S.C. 102 (b)) as being anticipated by Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached PTO-892).

3. As per claim 1, Jones et al. teach a method for distributing bank cards, comprising:

identifying a pool of potential new bank account holders for a bank (see Fig. 1; column 1, line 29; column 27, lines 32-43; 41-48; where customer Leads from Micro-marketing Center (11) fed to Central Database (10) which ultimately led to Business Feed (22) which include different services provided by the bank such as shown Fig. 13A);

determining if a person from the pool is an existing bank account holder (see Fig. 1; Fig. 10 A and 10 B; column 44, lines 10-14; where sales leads from Micro-marketing Center segregated into new customer and existing customer based on information entered to identify customer and the sales campaign (Fig. 8C));

determining whether the person is eligible for opening a new bank account if the person is not an existing bank account holder (see Fig. 6B; Fig. 10B);

creating a bank card including embossed information and magnetic stripe information, wherein the card is a dead bank card; and distributing the dead bank card to the person (see Fig. 16A; column 55, lines 34-43).

4. As per claim 2, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the pool is identified based on the region or regions served by the bank issuing the new bank accounts (see column 9, lines 46-51).

5. As per claim 3, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the pool is identified based on individuals applying for new credit account (see Fig. 10 B).

6. As per claim 4-8, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the pool is identified based on a life event comprising a move to a new residence, a marriage or divorce, a death of a partner or spouse, a birth or a new phone account (see Fig. 6C, Display Customer Needs and Notes Screen; column 1, lines 38-52; column 35, lines 51-57).

7. As per claim 9, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method including

determining whether the person was a previous bank account holder (see Fig. 10A; where Greeter identify customer by reviewing the profile to prepare for session).

8. As per claim 10, Melchione et al. teach claim 9 as described above. Melchione et al. further teach the method including

determining why the person closed the previous bank account in the event the person was a previous bank account holder (see Fig. 10A; steps 200 and 300).

9. As per claim 11, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the step of determining whether the person is eligible comprises evaluating credit score information supplied by a credit bureau (see 12 B-C; column 49, lines 53-67).

10. As per claim 12, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the step of determining whether the person is eligible comprises

determining whether the person is an existing or past credit card account holder with the bank (see Fig. 10 A and 10 B); and

evaluating the payment history if the person is an existing or past credit account holder (see Fig. 10A).

11. As per claim 13, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the step of determining whether the person is eligible comprises evaluating the age of the person (see Fig. 12; column 49, lines 17-25; where preliminary profile include collection of social security number and date of birth).

12. As per claim 14, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method comprising

the step of prebuilding an account if the person is determined to be eligible, thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person (see column 7, lines 59-67 to column 8, lines 1-7; column 9, lines 53-64).

13. As per claim 15, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the bank card is a debit card or check card (see column 53, lines 32-42).

14. As per claim 16, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the bank card is an ATM card (column 35, lines 39; column 58, line 40).

15. As per claim 17, Melchione et al. teach a method of distributing bank cards, comprising:

receiving a customer application for a credit card to be issued by a bank (see Fig. 10A/10B; Fig. 13A; column 45, lines 1-9; where greeter identifies customer needs and receives information from credit card applicant);

processing the application to determine a decision on the credit card (see Fig. 13 A, H, K-M; Column 53, lines 7-20; column 54, lines 6-17);

determining whether the customer is an existing bank account holder of the bank (see Fig. 10A);

distributing a live credit card to the customer if the application is approved and the customer is an existing bank account holder; and distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder (see Fig. 10A and 10 B; column 53, lines 22-42; where secured and unsecured credit card can be issued to existing and new account holder; Examiner notes that current reference has system to distribute live card (secured) to existing account holder and live card and dead card (which need to be activated) to the new customers).

16. As per claim 18, Melchione et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

the step of determining if the customer is eligible to be a bank account holder of the bank (see Fig. 6B).



17. As per claim 19, Melchione et al. teach claim 18 as described above. Melchione et al. further teach the method wherein

the step of determining if the customer is eligible comprises determining whether the customer resides within the bank account service footprint of the bank (see Fig. 6C; column 35; lines 49-57).

18. As per claim 20, Melchione et al. teach claim 18 as described above. Melchione et al. further teach the method wherein

the step of determining if the customer is eligible comprises performing a credit check or risk analysis supplemental to that performed for the credit card application (see Fig. 11C; Fig. 12B-C; column 49, lines 35-59).

19. As per claim 21, Melchione et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

the step of determining whether the customer is a past bank account holder of the bank (see Fig. 10A; where Greeter identify customer by reviewing the profile to prepare for session).

20. As per claim 22, Melchione et al. teach claim 21 as described above. Melchione et al. further teach the method comprising

determining the reason the past bank account was closed and evaluating the reason prior to the decision to distribute a dead bank card to the customer (see Fig. 10A/B; column 34, lines 20-39).

21. As per claim 24 -25, Melchione et al. teach claim 17 as described above. Melchione et al. further teach the method wherein

the live credit card and dead bank card are communicated to the customer in a single mailing or different mailings (see Fig. 16A; column 18-29; where bank issues different credit cards (secured and unsecured), mailing of which can be of together or separately).

22. As per claim 26, Melchione et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

prebuilding a new bank account for the customer prior to distributing the dead bank card (see column 7, lines 59-67 to column 8, lines 1-7; column 9, lines 53-64).

23. Claims 27-32, 37-38 and 40 are rejected under 35 U.S.C. 102 (e)) as being anticipated by Jones et al. U.S. Pub No. 2004/0117300 (reference B in attached PTO-892).

24. As per claim 27, Jones et al. teach a method of distributing solicited credit cards and unsolicited bank cards, comprising:

receiving from a customer an application for a credit card to be issued by a bank (see Fig. 2A);

processing the application (see Fig. 2B);

determining if the customer is an existing bank account holder with the bank (see Fig. 2B, steps 122 and 124); paragraph [0096]))

distributing a live credit card to the customer if the application is approved and the customer is already an existing bank account holder (see Fig. 2B);

distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder (see Fig. 4; paragraph [0074] and [0075]); and

processing a customer response to the dead bank card (see Fig. 5A-B).

25. As per claim 28, Jones et al. teach claim 27 as described above. Jones et al. further teach the method wherein

the customer response accepts the new bank account associated with the dead bank card, and wherein the processing comprises funding the new bank account (see Fig. 5A; Fig. 5c, step 274).

26. As per claim 29, Jones et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from a customer-supplied source of funds (Fig. 5c, step 274; paragraph [0091]).

27. As per claim 30, Jones et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from the credit account associated with the live credit card distributed with the dead bank card (Fig. 5c, step 274; paragraph [0091]).

28. As per claim 31, Jones et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is an incentive deposit provided by the bank to incentivize the customer to accept the new bank account (see Fig. 5C, steps 282-290; paragraph [0088]), [0095]).

29. As per claim 32, Jones et al. teach claim 27 as described above. Jones et al. further teach the method wherein

the credit card and the bank card are linked through a reward or rebate program (see paragraph [0090], [0091]).

30. As per claim 37, Jones et al. teach a method of distributing bank cards by a sponsoring bank, comprising:

identifying a pool of potential universal bank account card holders (see Fig. 2A, step 104));

identifying a person from said pool for distributing an unsolicited offer for a universal bank account card (see Fig. 2A, step 106);

creating a universal bank card including embossed information and magnetic stripe information, the universal bank card including a universal bank account number to be associated by the person with an existing bank account held by a bank other than the sponsoring bank (see Fig. 2A/2B, steps 116/136); and

distributing the universal bank card to the person (see Fig. 2A, step 118; Fig. 4, step 184).

31. As per claim 38, Jones et al. teach claim 37 as described above. Jones et al. further teach the method comprising

activating the universal bank card upon receipt of a communication from the person including the designation of the existing bank account number (see Fig. 5A).

32. As per claim 40, Jones et al. teach claim 37 as described above. Jones et al. further teach the method wherein

the universal bank card is distributed in conjunction with live credit cards, and wherein the pool of potential universal account holders is identified from a pool of applicants for the credit cards (see Fig. 2A-B; Fig . 4).

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached PTO-892) in view of Strock et al., U.S. Pub No. 2004/0122736 (reference C in attached PTO-892).

35. As per claim 23, Melchione et al. teach claim 21 as described above.

Melchione et al. do not teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers.

Strock et al. teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to

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a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers (Strock et al., Fig. 3B; paragraph [0010].

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers of Melchione et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between Bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

36. Claim 33-36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. U.S. Pub No. 2004/0117300 (reference B in attached PTO-892) in view of Strock et al., U.S. Pub No. 2004/0122736 (reference C in attached PTO-892).

37. As per claim 33-34, 36 and 39, Jones et al. teach providing promotion based on activation of the card.

Jones et al. do not teach offering reward or rebated based on credit card usage.

Strock et al. teach offering reward or rebated based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include offering reward or rebated based on credit card usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

38. As per claim 35, Jones et al. teach claim 33 as described above. Jones et al. further teach the method, wherein

offering different levels of incentive to the customer to use the credit card and the bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the first rewards or rebates and the second rewards or rebates are different.

Strock et al. teach the first rewards or rebates and the second rewards or rebates are different (Strock et al., paragraph [0010]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include first rewards or rebates and the second rewards or rebates are different of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

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39. As per claim 36, Jones et al. teach claim 27 as described above.

Jones et al. further teach the method, wherein the bank provides the customer an incentive deposit of rewards or rebates to accept the new bank account associated with the dead bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage.

Strock et al. teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include offering first rewards or rebates based on credit card usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

### ***Conclusion***

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Buchanan et al. (U.S. Patent No. 5,950,179) teach method and system for issuing a secured credit card product.



Christiansen et al. (U.S. Patent No. 6,202,053) teach method and apparatus for generating segmentation scorecards for evaluating credit risk of bank card applicants.

Hall, III et al. (U.S. Patent No. 6,158,657) teach system and method for offering and providing secured.

Infosino (U.S. Patent No. 6,715,679) teaches universal magnetic stripe card.

Kishen et al. (U.S. Pub No. 2004/0103065) teach systems and method for soliciting customers using computer readable media.

Matada (U.S. Patent No. 6,817,521) teaches credit application automation system..

Mobed et al. (U.S. Patent No. 7,103,573) teach user rewards program and communication system.

Nabe et al. (U.S. Pub No. 2002/0194050) teaches methods and systems for supplying customer leads to dealers.

Nandakumar (U.S. Pub No. 2006/0081702) teaches system and method for universal consumer cards.

Rubio et al. (U.S. Pub No. 2002/0062241) teach apparatus and method for coding electronic direct marketing lists to common searchable format.

Sullivan (U.S. Pub No. 2004/0193539) teaches mutual fund card method and system.

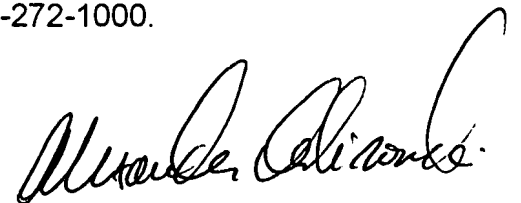
Wilkins et al. (U.S. Patent No. 6,868,389) teach internet-enabled lead generation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 7:00AM-4:30 PM(Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BKS

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", written in a cursive style.

ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER